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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,850	01/21/2004	Daniel R. Lynn	F-5581 CIP DIV DIV	3059

7590 05/03/2007
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EXAMINER

KIM, SUN U

ART UNIT	PAPER NUMBER
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1723

MAIL DATE	DELIVERY MODE
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05/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,850

Applicant(s)

LYNN ET AL.

Examiner

John Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/21/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/21/07</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and 4-9 of U.S. Patent No. 5,591,337 (Lynn ‘337).

Although the conflicting claims are not identical, they are not patentably distinct from each other

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because the second heat and pressure sealed region of Lynn '337 that joins the rims of the housing elements to the first heat and pressure sealed region of filter layers inherently forms a peripheral seal comprising a commingled melted matrix comprising material of the first and second housing elements and fiber filter media of the filter pad assembly. Method of claim 7 of the instant application is an inherent step of using the blood filter of Lynn '337.

3. Claims 1 and 4-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 4 and 6 of U.S. Patent No. 6,422,397 or US Patent No. 6,367,634 in view of U.S. Patent No. 5,591,337 (Lynn '337). Claims 1-2, 4 and 6 of U.S. Patent No. 6,422,397 or US Patent No. 6,367,634 teach the claimed blood filter device and method of claims 1 and 4-8 of the instant application except that the filter medium is a filter pad assembly comprising fiber filter media. Lynn '337 teaches filter pad assembly comprising fiber filter media that are heat and pressure sealable to form a seal (34) wherein the essential symmetry of the filter pad assembly (20) maximizes the surface area available for leukocyte removal as the peripheral seal (34) occupies only a relatively small area of the overall pad assembly (see col. 5, line 58 – col. 8, line 54). It would have been obvious to substitute filter pad assembly comprising fiber filter media that are heat and pressure sealable for filter medium of meltable filter layer of U.S. Patent No. 6,422,397 or US Patent No. 6,367,634. Method of claim 7 of the instant application is an inherent step of using the blood filter of U.S. Patent No. 6,422,397 or US Patent No. 6,367,634 in view of Lynn '337.

4. Claims 1 and 4-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and 4 of U.S. Patent No. 6,745,902 in view of U.S. Patent No. 5,591,337 (Lynn '337). Claims 1-2 and 4 of U.S. Patent No. 6,745,902 teach the

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claimed blood filter device and method of claims 1 and 4-8 of the instant application except that the filter medium is a filter pad assembly comprising fiber filter media. Lynn '337 teaches filter pad assembly comprising fiber filter media that are heat and pressure sealable to form a seal (34) wherein the essential symmetry of the filter pad assembly (20) maximizes the surface area available for leukocyte removal as the peripheral seal (34) occupies only a relatively small area of the overall pad assembly (see col. 5, line 58 – col. 8, line 54). It would have been obvious to substitute filter pad assembly comprising fiber filter media that are heat and pressure sealable for filter medium of meltable filter layer of U.S. Patent No. 6,745,902. Method of claim 7 of the instant application is an inherent step of using the blood filter of U.S. Patent No. 6,745,902 in view of Lynn '337.

5. Applicant's arguments filed 3/21/07 have been fully considered but they are not persuasive.

Applicants argue that Lynn '337 is directed to a first heat and pressure seal region and a second heat and pressure seal region formed after the first heat and pressure sealed region rather than a peripheral seal formed by the application of radio frequency heating and pressure in a single step to join first and second flexible housing elements directly to a filter pad assembly. Claim 1 is a product-by process claim. The blood filter of Lynn '337 is substantially identical to the claimed blood filter with exception of the process of making the filter. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious

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from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Applicants argue that Lynn ‘397 or Lynn ‘634 or Lynn ‘902 does not teach the intermediate layer of which comprises a fiber filter media. However, Lynn ‘377 teaches filter pad assembly comprising a second filter media layer i.e. an intermediate region comprising a fiber filter media (see col. 6, lines 45-47).

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

7. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is 571-272-1142. The examiner can normally be reached on Monday-Friday 7 a.m. - 3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John Kim
Primary Examiner
Art Unit 1723

JK
5/1/07